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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,485	05/29/2002	Lars Andresen	P 290643	3220

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
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EXAMINER

TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/069,485

Applicant(s)

ANDRESEN ET AL.

Examiner

Barry W. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al (6,404,869 hereinafter Henderson) in view of "E-Plus" pamphlet dated 1998 found on 1449 paper dated 1/25/06.

Regarding claim 1. Henderson teaches a method (abstract, figure 1) comprising:
maintaining subscriber information on at least one prepaid subscriber (see 106 figure 1 used to store subscriber information for subscribers);
defining at least two different prepaid profiles, each prepaid profile defining at least one attribute for the prepaid service (see 106 figure 1 used to define profiles such

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as card usage data having attributes of remaining minutes, unit billing rates (col. 5 lines 16-53), other profiles include location identifier(s) corresponding to geographic locations, telephone numbers having attributes of special, preferred, and discount telephone service rates (col. 5 lines 16-53);

associating the subscriber's subscriber information with one of the at least two different profiles (col. 5 lines 54-64), and

providing the prepaid service to the subscriber as indicated by the attribute defined in the one prepaid profile associated with the subscriber (col. 5 lines 41-47).

According to Applicants newly amended claim language Henderson fails to show the attribute indicating how the prepaid service is to be updated during recharge (see Applicants previously amended claims and brief comments, paper dated 10/17/05). Applicants further contend that Henderson not only fails to show how prepaid card is updated during recharge but is silent with respect to what happens when the prepaid card is not replenished during recharge (see Applicants remarks, paper dated 5/11/2006 starting on page 3 and continuing to page 6 (**especially the last five lines of page 6**)).

However, E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see

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page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claim 2. Henderson discloses carrying out associating during subscription provisioning (col. 5 lines 16-21).

Regarding claim 3. Henderson discloses updating subscriber information during recharge (col. 6 lines 14-23).

Regarding claims 4, 8 and 13. Henderson does not explicitly show the attribute of being a deposit function defining how to calculate the credit during recharge.

E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to

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provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claims 5, 9 and 14. Henderson does not explicitly show the attribute of being an expiry function defining how to calculate the validity time of the prepaid account.

E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claims 6, 10 and 15. Henderson does not explicitly show the attribute of being an expiry state handling function defining how the possibilities of a subscriber are limited over time when no recharge is carried out.

E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to

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prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claim 7. Henderson teaches a telecommunications system offering prepaid subscription services (see 104 figure 1), the system comprising at least one database (see 106 figure 1) having subscriber information on at least one prepaid subscriber, wherein the system is arranged to maintain at least two different profiles, each profile defining at least one attribute for the prepaid service (see 106 figure 1 used to define profiles such as card usage data having attributes of remaining minutes, unit billing rates (col. 5 lines 16-53), other profiles include location identifier(s) corresponding to geographic locations, telephone numbers having attributes of special, preferred, and discount telephone service rates (col. 5 lines 16-53); to associate the subscriber's subscriber information with one profile (col. 5 lines 54-64); and to provide the prepaid service to the subscriber as indicated by the attribute defined in the profile associated with the subscriber (col. 5 lines 41-47).

According to Applicants newly amended claim language Henderson fails to show the attribute indicating how the prepaid service is to be updated during recharge (see

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Applicants newly amended claims and brief comments, paper dated 10/17/05).

Applicants further contend that Henderson not only fails to show how prepaid card is updated during recharge but is silent with respect to what happens when the prepaid card is not replenished during recharge (see Applicants remarks, paper dated 5/11/2006, on starting on page 3 and continuing to page 6 (**especially the last five lines of page 6**)).

However, E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claim 12. Henderson teaches a network element (see 104 figure 1) in a telecommunication where subscribers of the system can prepay for their calls (col. 6 line 19) using prepaid card (120 figure 1) wherein network includes a database (see 106 figure 1, col. 5 lines 1-16 wherein database containing at least two different prepaid

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profiles for at least two different customers and wherein customer prepaid accounts associated with location identifier to be used to offer at least one attribute (i.e. location code used to indicate apply premium rate, or special rate, or discount rate)).

According to Applicants previously amended claim language Henderson fails to show the attribute indicating how the prepaid service is to be updated during recharge (see Applicants newly amended claims and brief comments, paper dated 10/17/05). Applicants further contend that Henderson not only fails to show how prepaid card is updated during recharge but is silent with respect to what happens when the prepaid card is not replenished during recharge (see Applicants remarks, paper dated 5/11/2006, on starting on page 3 and continuing to page 6 (**especially the last five lines of page 6**)).

However, E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to

provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claim 16. Henderson teaches defining profiles before accessing telecommunication system (col. 5 lines 16-21).

Regarding claim 17. Henderson teaches a network element comprising a processor configured to have access to subscriber information on prepaid subscribers and to at least two different prepaid profile definitions, each prepaid profile defining at least one attribute for the prepaid service, the attribute indicating how the prepaid service is to be provided, and to update, during a prepaid subscriber's account recharge, subscriber information on the prepaid subscriber according to a prepaid profile associated with the prepaid subscriber's subscriber information, the associated prepaid profile being one of the at least two different prepaid profiles (see 106 figure 1, col. 5 lines 1-16 wherein database containing at least two different prepaid profiles for at least two different customers and wherein customer prepaid accounts associated with location identifier to be used to offer at least one attribute (i.e. location code used to indicate apply premium rate, or special rate, or discount rate)).

Henderson does not show at least two different prepaid profiles to be used when update is to occur.

However, E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service

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provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Regarding claim 18. Henderson teaches a network element comprising: means for obtaining subscriber information of prepaid subscribers who can prepay for their calls by recharging their accounts via vouchers; means for obtaining to at least two different prepaid profile definitions, each prepaid profile defining at least one attribute for the prepaid service, the attribute indicating how the prepaid service is to be provided; and means for updating the subscriber information during recharge according to a prepaid profile associated with the recharging prepaid subscriber's subscriber information, the associated prepaid profile being one of the at least two different prepaid profiles (see 106 figure 1, col. 5 lines 1-16 wherein database containing at least two different prepaid profiles for at least two different customers and wherein customer prepaid accounts associated with location identifier to be used to offer at least one attribute (i.e. location code used to indicate apply premium rate, or special rate, or discount rate)).

Henderson does not show at least two different prepaid profiles to be used when update is to occur.

However, E-Plus already teaches customized method for prepaid service wherein at least two different prepaid profiles are offered to user which define how the prepaid service is updated during recharge (see left side of page 1 wherein more options provided to prepaid card users, see left side of page 2 wherein prepaid service provides great flexibility to users, see right side of page 2 wherein attributes listed for at least two different prepaid profiles which provide for customized prepaid service, see page 3 wherein prepaid card will lapse when prepaid card not replenished during recharge). E-Plus teaches at least three different methods of used to recharge (see right side of figure 2 wherein cash, credit card or bank transfer (i.e. bank voucher)).

It would have been obvious for any one of ordinary skill in the art at the time of invention to utilize the teachings of E-Plus into the teachings of Henderson in order to provide for a more flexible prepaid service that allows users more options to choose from when recharging prepaid service.

Response to Arguments

2. Applicant's arguments filed 12/18/06 have been fully considered but they are not persuasive.

a) Applicants generally argue that Henderson does not disclose, teach or suggest defining at least two different profiles (third paragraph on page 6, paper dated 12/18/06).

First of all, Applicants do not define what is meant by at least two profiles and some independent claims are so broad that Henderson database shown in figure 1 would only have to store prepaid card information for only two subscribers wherein each profile for the two separate subscribers would include information relating to location identifier so as to associate premium, preferred or special rate to each prepaid call.

b) Next, Applicants generally argue that E-Plus fails to remedy the deficiencies of Henderson. Specifically, E-Plus fails to disclose, teach or suggest, for example, defining at least two different prepaid profiles, each prepaid profile defining at least one attribute for the prepaid service, the attribute indicating how the prepaid service is to be provided; associating the prepaid subscriber's subscriber information with one of the at least two different prepaid profiles, and providing the prepaid service to the prepaid subscriber as indicated by the attribute defined in the one prepaid profile associated with the prepaid subscriber's information (see bottom of page 6 continuing to page 7, paper dated 12/18/06).

The Examiner notes again, that Applicants refuse to amend or argue what is meant by "defining at least two different prepaid profiles, each prepaid profile defining at least one attribute for the prepaid service, the attribute indicating how the prepaid service is to be provided; associating the prepaid subscriber's subscriber information with one of the at least two different prepaid profiles, and providing the prepaid service to the prepaid subscriber as indicated by the attribute defined in the one prepaid profile associated with the prepaid subscriber's information". Applicants keep repeating claim language as arguments but refuse to explain what Applicants consider the invention to

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be? The Examiner is kindly requesting Applicants to please explain what is meant by PROFILES and ATTRIBUTES?

Henderson clearly teaches profiles (i.e. location identifiers) associated with premium rate or special rate, which would clearly read on the broadly claimed limitation of "ATTRIBUTE". E-Plus clearly teaches different recharging profiles having deposit attributes associated thereto.

c) Applicants conclude by generally argue the alleged motivation, to "provide for a more flexible prepaid service that allows users more options to choose when recharging prepaid service", does not appear to have any relevance either to the claims or to the combination of Henderson and E-Plus and no evidence in any of the references is provided to support this conclusion. It is also not clear as to how the teaching that the account may be recharged with different amounts discloses, teaches or suggests that a subscriber's information is updated during the recharge. Furthermore, the claimed attribute is not selectable by the user at the time of the recharge.

The Examiner respectfully disagrees. Support may be found in E-Plus. See page 2 for example wherein a new telephone card for mobiles is disclosed wherein no binding contract and no monthly fees are required and customers have complete control on how and when to recharge. In other words, E-Plus teaches one card with different profiles having attributes (see page 2 of E-Plus wherein seven different profiles are listed having different recharging attributes), which alone reads on Applicants vague independent claim language. E-Plus also allows for cash, credit card or bank transfer

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(i.e. voucher) to be used for recharging (see bottom right side of page 2 and the last two lines on the right side of page 3).

Conclusion

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Thursday, 6:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost, can be reached at (571) 272-7872. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Centralized Delivery Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (571-273-8300).

Barry W. Taylor
Art Unit 2617


BARRY TAYLOR
PRIMARY EXAMINER